

## **REMARKS**

Claims 11 – 15, 53 – 57 and 71 – 74 are pending. All other claims are canceled without prejudice or waiver to re-file in a separate application.

The rejections are addressed below in detail. Reconsideration is respectfully requested.

¶ 4: Rejection of claims 14 and 56 under §112 (¶ 1) based on “Connection-by-Connection Basis” language and claims 72 and 74 based on “data content is configured based on a processing capability”

Applicant incorporates by reference the previously submitted declaration to Dr. Melvyn and further points out the following in support of these claims.

The Examiner’s main objection at this point for claims 14 and 56 is that the SR engine initialization processes are - in his opinion - “...separate and distinct from the boxes for opening and closing an Internet session.” For this reason the Examiner contends that the initialization of the client speech recognition engine is not on a connection-by-connection basis, but appears to be “....an independent process occurring even before the Internet connection is established.” See page 3 of the Office Action.

Applicant submits that even if this perspective is accurate, there is nothing irreconcilable with this view of the specification and the claim language as submitted. First, it stands to reason that the communication processes and SR processes can be independent – this is just good engineering/programming practice.

But the second part of the Examiner’s observation is not well founded because, as the Examiner appreciates, the specification sets out that in the preferred embodiment the SR engine is not *configured* until it is determined what the capabilities are of the client and server respectively. Unless one always connects to the same server (and there is no requirement in the specification that such be done) with the same client this information clearly cannot be ascertained without first establishing a connection between the two respective devices, i.e. a particular client and a particular server.

Consequently the Examiner's suggestion that the *initialization* of the SR engine is not on a connection by connection basis because it occurs *before* the Internet connection is established is both inaccurate and not pertinent. It is plainly inaccurate for the reasons above, namely, initialization of the SR engine may occur at different times. It may not even be necessary until the user decides to engage in a speech session with the server, which can be after the connection is made.

Moreover the Applicant is not sure why the Examiner has determined the "initialization" of the SR engine is relevant, since the claim makes no mention of such. It only states that the:

"...additional data content including a set of delta and acceleration coefficients is computed from said set of compressed MFCCs at either said client system or said server computing system on a connection by connection basis based on an evaluation of computing resources available at such client system and said server computing system."

Thus the claim makes no mention of the *initialization* process that the Examiner apparently objects to beginning before the connection process, nor – as the Examiner can see from the plain language - does it matter. All that the claim states is that there is an evaluation of computing resources available at the client system and the server computing system. It is possible that such resources are known in advance, and the specification contemplates such scenario by explaining that a default value could be used whereby a fixed/set division is used (page 21, ll. 1 – 3 for client and ll. 4 – 11 for the server). But the specification also explicitly mentions the possibility of performing an actual measurement, which means the SR engine could not be configured until there was a connection made to determine the respective amount of resources (see e.g. page 29, l. 10 – page 30, l. 26.)

For these reasons the Applicant submits that the claim is adequately supported by the original written description, and requests reconsideration of the same.

As for claims 72 and 74: the rejection is not entirely understood, but the Examiner apparently takes issue with the language "portable device." This is traversed, because the Examiner acknowledges that the partitioning is done between a client and a server based on processing abilities of both. The specification sets out many

examples of client devices, including PDAs, cellphones and notebook/laptop computers as the Examiner also recognizes. Any/all of these devices are portable electronic devices, which means the specification as filed explicitly supports the language of the claim. Reconsideration is requested for this as well.

¶ 9: Response to Rejection of Claims 11 – 13, 53 – 55, 71 and 73 under §103(a) in light of Barclay et al. taken with Lennig et al.

The rejection of these claims is traversed on several grounds.

The new rejection is improper and violates the PTO compact prosecution rules

First, the Applicant submits that the Examiner has already acknowledged (see Office Action of September 4, 2007) the deficiencies of the Barclay et al. reference, including the fact that it does not disclose the last limitation of independent claim 11. There is no explanation, suggestion or hint by the Examiner that his earlier analysis was incomplete or incorrect. The Examiner's express statement was that Barclay et al.:

does not expressly disclose

"said representative speech data values including a set of compressed mel-frequency cepstral coefficients (MFCC)", or the limitation of "and said communications channel further being configured by the machine executable program such that grammar related information is sent to the second processing routine executing on the server computing system for identifying a grammar to be used for recognition of said one or more words and said sentences." I

See Office Action of September 4, 2007. The Examiner's evaluation showed at that time that Barclay et al. did not show the "grammar related information" limitation of the claim. Instead the Examiner insisted that *another* reference (He et al.) disclosed this limitation (Id at pp. 7 – 8) and argued only that the combination of references made the claim obvious.

Nonetheless after the Applicant pointed out that He et al. is not prior art, the Examiner has now strangely changed course and now argues exactly the opposite: namely, that the Barclay et al. reference *does* indeed show this limitation. See Office Action of November 21, 2008, pages 6 – 7. Applicant does not know what to make of this recent dramatic change in thinking, because there is no explanation of why the earlier analysis is wrong, and is disappointed by what appears to be very arbitrary and unnecessarily prolonged examination of the current subject matter. The interpretation of the references should not vary so dramatically over time as it now leads to inconsistent results, and unpredictable prosecution.

More to the point, the Examiner's new interpretation of the reference runs afoul of the PTO rule that requires compact prosecution. As the PTO itself has explained, "[t]he Office's policy of compact prosecution requires that both examiners and applicants provide the information necessary to raise and resolve the issues related to patentability *expeditiously*." (Official Gazette of 07 November 2003). The Examiner's new change of mind, presented with no explanation or rational basis, unnecessarily multiplies and extends the prosecution clearly, and is not consonant with PTO policy.

It is well accepted that the first Office Action on the merits should identify every issue that stands between the applicant's claims and allowance of the application. (See The Manual of Patent Examining Procedure (MPEP) §707.07(g)). The Office Action should do so by presenting the best case against patentability. In this instance it is apparent that this has not happened. The Examiner is well familiar with the Barclay et al. reference as a result of prosecutions extending almost 10 years in the present applications. If he truly believed it disclosed all the above limitations of the claim, it seems logical that he would have relied on that *simple* and straightforward analysis rather than invent a whole different more difficult interpretation which at that time required him to combine it with another reference.

As a preliminary matter therefore Applicants traverse the most recent change in the interpretation of the Barclay et al. reference as it violates the PTO rule against compact prosecution and is in direct conflict with the instant Examiner's prior analysis. Under the Examiner's treatment of this case, prosecution will continue indefinitely because interpretations of the references is constantly changing, and no certainty is

ever reached on the scope of the teachings of such. This type of inconsistent treatment is in violation of the Applicant's rights to pursue expedient allowance of patentable subject matter.

Barclay et al. does not even disclose the limitation in question of sending grammar related information to the second processing routine

More importantly the Examiner's new characterization of Barclay et al. is simply incorrect and based on a strained interpretation. The only support for the new contention is this conclusory statement in the recent Office Action:

"..when a client selects a Web page for a weather report, *it notifies a server to employ a grammar* for recognizing words and phrases associated with the weather" (emphasis added)

The problem with this speculation by the Examiner is that in the above example, there is no "grammar related information" being *sent* to the server. The Examiner states that selecting the *web page* would specify a grammar; but for the browser scenario suggested by the Examiner, this would involve merely sending a URL to the server to identify a specific webpage to be loaded, not "grammar related information for identifying a grammar to be used for recognition."

As the Examiner can imagine, a particular webpage may have multiple associated grammars, and the provision of the URL alone would not inform the server about which if any of such to use. Thus it cannot "identify" a grammar to be used in the first place.

In addition, in embodiments of the present claims, grammar configuration information can be updated and sent to the server when user changes context within a web page. So a grammar at the server can be updated dynamically as the user changes context at client on the same web page. In contrast even if the grammar download technique suggested by the Examiner occurs in Barclay it would be static for that page - i.e. as long as the user is on a web page for weather, the grammar used for that page refers only to weather. In contrast, in embodiments of the present claims it might refer to weather for specifically for Boston, and when the user changes to a context of that involves Dallas and surrounding areas, another grammar might be

selected or configured to provide words etc. which are specific to Dallas and excludes words that relate to Boston.

Lennig is cited purely for its discussion of MFCCs, which cannot cure the underlying problems in Barclay et al. Consequently claim 11 should be allowable for at least the reasons noted above.

Dependent claims 12 – 14 should be allowable for at least the same reasons as claim 11.

Independent claim 53 should be allowable for at least the same reasons as claim 11. Dependent claims 54 - 55 should be allowable for at least the same reasons as claim 11.

Claims 71 and 73 depend from claim 11 and should be allowable for at least the same reasons. In addition, the Examiner cites the LISTEN button within the GUI of Barclay, but it is clear that in such embodiment the “button” is “clicked” (i.e. with a mouse only) – not “pressed” as the claim sets out, which would allow for non-mouse applications. Accordingly this is another reason these claims are allowable.

¶ 7: Response to Rejection of Claims 15, 57, 72 and 74 under §103(a) in light of Barclay et al. taken with Lennig et al. and White et al.

For claims 15 and 57, Applicant incorporates by reference the discussion above as concerns the improper prosecution of claim 11. Claims 15/57 originally were rejected solely in light of Applicant’s own ‘977 disclosure – see Office Action of September 4 2007, page 3, paragraph 7. Now, again that this disclosure is demonstrated not to be prior art, the Examiner has again completely changed the rejection, and now asserts that there is a yet another different combination of references that applies to these claims. As above the rejection is not well founded because the Examiner was already well-familiar with the White et al. reference at the time and should have issued any such rejection at the time, rather than engaging in piecemeal prosecution which now causes Applicant to lose even more potential enforceable rights in the present subject matter.

The Examiner now cites White et al. for the following proposition:

However, *White et al.* ('272) teaches a distributed voice user interface, where a number of factors are considered in dividing speech recognition functionality between local devices 14 and remote system 12. These factors include an amount of processing and memory capability available at each of local devices 14 and remote system 12, the bandwidth of the link between each local device 14 and remote system 12, and the kinds of commands expected from the user. (Column 5, Lines 23 to 37) Implicitly, by optimizing division of functionalities between a local device and a remote system, distributed speech recognition is faster, or has lower latencies, than would be present without the optimization ("with a latency that is less than a second latency"). An advantage is to provide a bulk of hardware and/or software

The Examiner's logic is that dividing functionality "implicitly" results in lower latencies. However if that is always the case, then it is apparent that *White et al.* does not engage in the kind of *configuration* of the SR engine as described in the claim which states:

....wherein said second processing routine is *configured* with an amount of resources by said server computing system based on a bandwidth and transmission speed associated with a transmission link between said server computing system and said client system so that said second processing routine performs accurate recognition of said one or more words with a first latency that is less than a second latency that would result if said one or more words were recognized by said first signal processing routine and then transmitted over said transmission link.

By the Examiner's reckoning, *White et al.* meets this limitation solely because the SR functions are divided. But the Examiner's use of the term 'implicitly' is simply a euphemism for "inherently" and he has not satisfied the burden of the law in this respect to show that *White et al.* can operate this way. As the case law establishes:

...that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be

established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)

In this instance the Examiner has not considered the fact that White et al. does not show any consideration or mention of dividing the SR functions in a manner that specifically reduces latency based on the specific conditions in the link. White et al. simply always divides the SR functions in the same way and does not show any concern for latency. Since that is the case, it can be seen clearly that there are plenty of scenarios by which the "division" of speech recognition functions in White et al. would result in latencies that vary dramatically. For example in a case with a powerful client, fast link and fast transceiver, the "second" latency could be less than the "first" latency as set out in the claim.

Consequently because of the inherent limitations in the reference the Examiner has not and cannot demonstrate that White et al. necessarily operates in accordance with the claim language, which requires a particular relationship between the actual latencies. For this reason claims 15/17 should be allowable - again.

Claims 72 – 74 depend from claims 11, 53 respectively and should be allowable for at least the same reasons.

¶ 8: Response to Rejection of Claims 14 and 56 under §103(a) in light of Barclay et al. taken with Lennig et al., White et al. and Huang et al.

For claims 14 and 56, Applicant incorporates by reference the discussion above as concerns the improper prosecution of claim 11. Claims 14/56 originally were rejected solely under §112 – see Office Action of September 4 2007, page 3, paragraph 5.

Now the Examiner has again added yet another rejection, but unfortunately does not identify *what* in the references he is citing against the "... connection by connection basis" language found in the claim. Applicant finds no mention of such type of functionality in the references, and on this basis traverses the rejections. These

claims should therefore be allowable at this time, or at a minimum, Applicant should be given an opportunity to understand the Examiner's rejection.

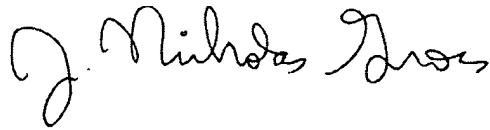
Conclusion

The prior art, arguments and rejections cited by the Examiner have been carefully considered by the Applicants, and addressed in detail for each of the pending claims. Applicants submit that the pending claims should be allowable, in light of the explanations and amendments presented.

A petition and fee for an extension of time is also enclosed. Please charge any fees due to deposit account no. 501-244.

Should the Examiner wish to discuss any aspect of the present case in person, the undersigned is available at any convenient time for a telephone conference (510) 540 – 6300.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. Nicholas Gross". The signature is fluid and cursive, with the first name "J." and last name "Gross" clearly distinguishable.

J. Nicholas Gross  
Registration No. 34,175  
Attorney for Applicant(s)

April 21, 2009  
2030 Addison Street  
Suite 610  
Berkeley, CA 94704  
(510) 540 – 6300  
(510) 540 – 6315 (fax)